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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|-------------------------|-------------------------|------------------|
| 09/991,404 | 11/16/2001 | Kenneth C. Oesterle JR. | 265-001 | 3309 |
| 7590 | 12/09/2004 | | EXAMINER | |
| John G. Chupa Law Offices of John Chupa & Associates, P.C. 28535 Orchard Lake Road Suite 50 Farmington Hills, MI 48334-2918 | | | CHRISTMAN, KATHLEEN M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3713 | |
| | | | DATE MAILED: 12/09/2004 | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------|----------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/991,404 | OESTERLE, KENNETH C. |
| | Examiner | Art Unit |
| | Kathleen M Christman | 3713 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 23 August 2004.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-11 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-11 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 28 March 2002 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the method for typing a word using a phonetic alphabet, the method for learning the orthographic spelling of a word, and the method for determining an orthographic spelling and definition of a word must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Applicant has failed to submit a drawing correction in the proper form to overcome the objection as raised in the previous office action dated 02/10/2004. This objection is maintained.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES**Replacement Drawing Sheets**

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment. Any replacement drawing sheet must be identified in the top margin as "Replacement Sheet" (37 CFR 1.121(d)) and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin.

Annotated Drawing Sheets

A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be submitted or required by the examiner. The annotated drawing sheets must be clearly labeled as "Annotated Marked-up Drawings" and accompany the replacement sheets.

Timing of Corrections

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

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If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings MUST be filed within the THREE MONTH shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 4-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4 and 7 recite the limitation "said typeable phonetic spelling". There is insufficient antecedent basis for this limitation in the claim. Claim 8 provides for the use of the dictionary to determine a orthographic spelling, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. Claims 9-11 are rejected for their incorporation of the above through their dependencies.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Gasper (US 4884972).

Regarding claim 1, Gasper teaches providing a plurality of bics, wherein said plurality of bics are comprised of typeable roman letters and combined typeable roman letters, see Figure 2k element 29 and

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col. 6: 35-38; and combining at least one of said plurality of bics to phonetically spell said word, see Figures 2c-2p. Assigning a certain sound to a unique one of each of said plurality of bics, as in claim 2, is shown in col. 10: 16-27. Arranging said bics, which include the typeable roman letters and the combined typeable roman letters into a pronunciation key, claim 3, is shown in Figures 6a-b and 9.

4. Claims 4-6, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Siegel (US 5799267). Siegel teaches providing a typeable phonetic alphabet, see col. 9: 39-49 (claims 4 and 8); and providing a dictionary which is arranged based upon said typeable phonetic alphabet, see "talking Dictionary" starting in col. 4: 14+. The user spelling out the word, claims 4 and 9, is taught in Table 2 element 2 found in col. 4. Comparing and contrasting the phonetic spelling and the orthographic spelling (claim 4) is taught in table 3, found in col. 7. A pronunciation key, as in claim 5, is shown in col. 9:46-49. Assigning a certain sound to a unique on of each of the roman letters and combined roman letters, as in claim 6, is inherent to the functionality of the system. The system is incapable of producing vocalized text without each possible phoneme having an assigned textually representation.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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5. Claims 7, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siegel (US 5799267). Siegel teaches all aspects of the claimed invention as shown above, but fails to specifically teach: the step of comparing and contrasting including providing an alphabetical listing of words spelled using the typeable phonetic spelling and providing the orthographic spelling and definition of a word in close proximity to the phonetic spelling (claim 7 and similar limitation of claim 10); and the word being in a different language than the definition (claim 11). The examiner notes that Siegel does teach that the phonetic spelling, definition, and orthographic spelling of each word is stored in the database, see table 1 in col. 4. The examiner takes official notice that it is old well-known in the art of language education to display each of these elements to a user. The examiner also takes official notice that these practices are commonly used in the art of foreign language education. It would have been obvious to one of ordinary skill in the art to modify the Siegel system with the above so as to allow a user of the system to visual compare the phonetic and orthographic representation of a word with the actual definition so as to reinforce the relationship between the spelling, pronunciation, and definition of the word. Similarly it would have been obvious with one of ordinary skill in the art to use this system to teach foreign languages so as to allow the user to visualize the spelling, and pronunciation of a foreign word with its native definition and thus reinforce the relationship.

Response to Arguments

6. The previous rejections of claims 1-3 and 8-11 under 35 USC §112, second paragraph have been withdrawn in view of the amendments made thereto. A rejection of claims 4-7 remains. A new rejection of claims 8-11 under 35 USC §112, second paragraph has been made, in view of applicant's amendment to the claims.

7. Applicant's arguments filed 08/23/2004 have been fully considered but they are not persuasive.

Arguments concerning the Gasper reference:

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Applicant generally argues that Gasper does not establish a phonetic alphabet or a pronouncing dictionary. However the term phonetic alphabet is a preamble term that fails to breath life and meaning into the claims since it is not 'essential to point out the invention defined by the claim'. *Kropa v. Robie*, 88 USPQ 478, 481 (CCPA 1951). Further, the term does not limit the structure of the claimed device. *In re Stencil*, 4 USPQ2d 1071 (Fed. Cir. 1987). Finally, the term recites an intended use of structure where the claim body does not depend on the preamble for completeness such that the structural limitations stand-alone. *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976). Therefore the structural limitations of the claims are interpreted in and of themselves, and as such Gasper clearly teaches the limitations of the claims, as shown above.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a pronunciation dictionary) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Arguments concerning the Siegel reference:

Applicant again generally argues the reference stating that Siegel fails to establish a phonetic alphabet. The applicant has made general assertions regarding the Siegel reference, but fails to show how the cited portions of the Siegel reference fail to meet the claim limitations. Generally applicant argues that their "modern phonetic dictionary" is the distinguishing feature. However, applicant is not claiming this dictionary, they are claiming several processes for learning or determining. The limitations of the phonetic dictionary, which applicant argues, are not recited in the claims. For example, nowhere does applicant claim a phonetic key comprising 39 sounds. The applicant has not challenged the examiner's taking of official notice, but appears to be challenging the case of obviousness. However, applicant has provided no evidence or direct arguments challenging the examiner's *prima facie* case of obviousness. The mere assertion that the combination is not obvious is not sufficient to overcome the rejection.

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Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Christman whose telephone number is (571) 272-4435. The examiner can normally be reached on M-F 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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